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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91160913
Party	Plaintiff Tiffany (NJ) Inc. ,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TIFFANY (NJ) INC.,	:	
	:	
Opposer,	:	
	:	
-against-	:	Opp. No. 91160913
	:	
ANTHONY SIRAGUSA and MICHAEL ROMANELLI,	:	
	:	
Applicants.	:	

OPPOSER'S OPPOSITION TO APPLICANTS' MOTION FOR LEAVE TO FILE AN AMENDED ANSWER

Opposer Tiffany (NJ) Inc. hereby opposes Applicants' Motion to Amend their Answer to Opposer's Complaint to add a new affirmative defense of equitable estoppel. Applicants have entirely failed to make the showing required by Fed. R. Civ. P. 15(a) and TBMP § 507.02.

In deciding Applicant's motion for leave to amend, the Board must consider whether there is any undue prejudice to Opposer and whether the amendment is legally sufficient and not futile. *See, e.g.*, Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302, 305 (1991) (citations omitted). The question of prejudice is largely dependent upon the timing of the motion to amend, and the burden to explain a delay is on the party that seeks leave to amend. *See* TBMP § 507.02(a); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540, 1541 (T.T.A.B. 2001). Thus, the question of delay requires the Board to focus on the moving party's reasons for failing to seek leave to amend sooner.

Here, Applicants claim they have "not unreasonably delayed in requesting to file the amended answer" because "[o]nly recently has Applicant's counsel learned of several facts upon which the amended answer is based." (App. Mot. at 2.) This claim is false. At a minimum,

Applicants have been aware of the facts upon which they premise their new affirmative defense since October 2004.

The equitable estoppel defense Applicants seek to add is based on the proposition that "representatives of Opposer have reserved and used Applicants' restaurant using the mark TIFFANY'S RESTAURANTS for official parties for Opposer's officers and employees." (App. Mot. to Amend., Ex. A at ¶ 35.) Applicants' own document production shows that Applicants were aware of this by October 2004, when an administrative assistant from Tiffany & Co.'s Parsippany office apparently sought to reserve Applicants' Pine Brook location for a holiday party. In fact, Applicants even included documents regarding this defense in their December 21, 2004 opposition to Opposer's Motion to Compel, as Exhibit A. *See also* App. Mot. to Amend at 2 ("Applicants had produced documents supporting this affirmative defense . . . ."). Applicants offer no explanation or justification for why they delayed almost 10 months – almost until the close of discovery – in seeking to amend their answer to include this new defense.

It also is clear that Opposer will face prejudice from an amendment adding a new affirmative defense less than one month before the September 20, 2005 close of discovery. There is no time for discovery, and in fact Applicants deliberately have prevented Opposer from taking necessary discovery. Specifically, Opposer has been unable to depose Applicant Anthony Siragusa, despite noticing his deposition three times since the commencement of this action, and requesting six times in the last two months that Applicants provide available dates for his deposition. How can Applicants claim that their proposed amendment will not prejudice Opposer when, at the same time, Applicants are preventing Opposer from obtaining discovery?

In addition, Applicants' proposed amendment is legally insufficient and futile. The affirmative defense of equitable estoppel requires that a defendant prove (1) misleading conduct

which leads another to reasonably infer that rights will not be asserted against it, (2) reliance upon this conduct, and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. *E.g.*, *Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 23 U.S.P.Q.2d 1701, 1703 (Fed. Cir. 1992) (citation omitted). Here, there is no way that a party arranged *four months after this action commenced* in June 2004, and apparently held thereafter, reasonably could have misled Applicants to infer that Opposer would not assert rights against it – especially since the parties actually were engaged in motion practice in this opposition at that time.

CONCLUSION

For the reasons set forth above, Applicants' motion to amend their answer to add the affirmative defense of equitable estoppel should be denied in its entirety.

Dated: New York, New York
August 30, 2005

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: _____

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached Opposition to Applicants' Motion for Leave to File an Amended Answer was served by prepaid first-class U.S. Mail on August 30, 2005, on Scott E. Charney, Esq., Lerner, David, Littenberg, Krumholz & Mentlik, LLP, 600 South Avenue West, Westfield, New Jersey 07090, counsel for Applicants Anthony Siragusa and Michael Romanelli.

Michelle Robinson

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